

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KOJI NOGUCHI

Appeal No. 1997-0008
Application 08/347,190

HEARD: February 22, 2000

Before KIMLIN, WARREN and LIEBERMAN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 7 and 8 as amended subsequent to the final rejection,¹ which are all of the claims in the application.

We have carefully considered the record before us, and based thereon, find that we cannot sustain the ground of rejection under 35 U.S.C. § 112, first paragraph. The basis for the rejection is

¹ Amendment of December 19, 1995 (Paper No. 16). See also the amendment of November 21, 1994 (Paper No. 12).

stated as “the specification as originally filed does not provide support or written description for the invention as currently claimed” (answer, page 3). While it may appear from this statement that the ground of rejection involves both the written description and the enablement requirements of § 112, first paragraph, the examiner has further stated in the answer (page 2) that “appellant’s statement of the issues in the brief is correct,” that is, “[w]hether the original disclosure provides adequate ‘written description’ support for claims 7 and 8 under [§ 112, first paragraph], and, more specifically, whether there exists inherent support for the recitation in claim 7 of ‘the magnetic brush brushing the surface of the photoconductive drum’” (principal brief,² page 6). Therefore, we find that the only ground of rejection before us is based on § 112, first paragraph, written description requirement. *See generally, Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1560, 19 USPQ2d 1111, 1114 (Fed. Cir. 1991).

In order to make out a *prima facie* case that the appealed claims do not comply with this section of the statute, the examiner must set forth evidence or reasons why, as a matter of fact, persons skilled in this art would not reasonably recognize in the disclosure in the specification a description of the invention defined by the claims which establishes that appellant was in possession of the invention, including all of the limitations thereof, at the time the original application was filed. *See, e.g., In re Alton*, 76 F.3d 1168, 1175-76, 37 USPQ2d 1578, 1583-84 (Fed. Cir. 1996). Appellant, in framing the specification, is under no requirement to “utilize any particular form of disclosure to describe the subject matter claimed.” *Alton*, 76 F.3d at 1172, 37 USPQ2d at 1581, and cases cited therein; *see also In re Wilder*, 736 F.2d 1516, 1520, 222 USPQ 369, 372-73 (Fed. Cir. 1984) (“The objects of the Invention may, in some cases, provide support for claims sought through reissue. [Citation omitted.]”). However presented, the disclosure in the specification must be considered from the view point of one skilled in the art, recognizing that that which is conventional in the art to this person need not be disclosed and can be established by evidence. *See, e.g., Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1571-72, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997) (“[T]he meaning of terms, phrases, or diagrams in a disclosure is to be explained or interpreted from the vantage point of one

² We have considered the principal brief filed May 2, 1996 (Paper No. 24) which was considered by the examiner (answer, page 1).

skilled in the art.”); *Alton*, 76 F.3d at 1175, 37 USPQ2d at 1583-84 (testimony in declaration offering factual evidence to expand the breadth of specification by showing the interpretation that one of ordinary skill in the art would have made of the disclosure therein is admissible with respect to whether that person would have understood from the disclosure that the claimed subject matter was in applicant’s possession at the time of filing); *cf. In re Howarth*, 654 F.2d 103,105, 210 USPQ 689, 691-93 (CCPA 1981) (While “[a]n inventor need not . . . explain every detail” of the claimed invention to comply with 35 U.S.C. § 112, first paragraph, enablement requirement, because “conventional knowledge will be read into the disclosure,” “the burden rests upon him to establish that those of ordinary skill in the art can be expected to possess or know where to obtain this knowledge.”). While the subject matter does not have to be described in the disclosure exactly as claimed, “the description must clearly allow persons of ordinary skill in the art to recognize that [appellant] invented what is claimed [citations omitted].” *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989); *see also Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1584 (“If a person of ordinary skill in the art would have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate written description requirement is met.”). Thus, where the same terms are not used in the specification and the claims, one skilled in the art must necessarily recognize in the disclosure an equivalent or inherent description of the claimed invention and not merely a description that would render obvious the claimed invention. *See Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1159, 47 USPQ2d 1829, 1834 (Fed. Cir. 1998) (“In order for a disclosure to be inherent, . . . the missing descriptive matter must necessarily be present in the . . . specification such that one skilled in the art would recognize such a disclosure.”); *Lockwood, supra* (“It is not sufficient for purposes of the written description requirement of § 112 that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose.”).

The examiner submits that appellant was not in possession of “the broader invention” because there is no “support” for the limitations of claim 7 in the embodiment set forth on pages 9-10 of the specification (answer, pages 4-5). The examiner contends, *inter alia*, that none of the specific

“features” of the process embodiment are found in said limitations and that this “process has not been shown to inherently produce a magnetic brush which brushes the surface of the photosensitive member as claimed,” concluding that the “specification fails to teach how to make and use the invention having a magnetic brush without a magnetically attractable material noting the carrier particles to form the brush” (*id.*).

Appellant counters that “due to the relative predictable art of the present invention, the single embodiment at pages 9-10 of the application indicates . . . possession” as claimed (principal brief, page 9). In support of his position, appellant submitted a declaration under 37 CFR § 1.132 from which he quotes with emphasis in the principal brief (page 10; underscoring omitted; italics supplied) with respect to that part of the embodiment disclosed at page 10 of the specification, the quote reading in pertinent part:

4. . . . One skilled in the art, however, would not consider a method with these particular features to be the only image-forming method discovered by the inventor. Instead, it would be *apparent* to one skilled in the art that the *inventor envisioned other methods* which similarly utilized a magnetic brush for contact-type developing, but in which some or all of the numerous features mentioned above would be varied. *Such methods include, for example, the method of claim 7.*

Appellant further contends that the limitation in claim 7 with respect to the “magnetic brush” is an “inherent feature” of the specific embodiment of which “would be apparent to one skilled in the art” from that disclosure (principal brief, page 12, with quotation of ¶ 3 of appellant’s declaration).

Appellant further relied on United States Patent No. 4,517,274³ as “showing a similar magnetic brush” (*id.*, pages 12-13).

The examiner responds that

there is only one method disclosed and enabled. The specification is devoid of any other specific or general discussion of the imaging method steps claimed using the claimed toner. The Summary of the invention on page 4 discusses the step of removing toner from the surface of an image carrier after transfer. This does not support the claimed method. The remainder of page 4 through the bottom of page 9 discuss only the instant toner. There is no discussion of a method on these pages. . . . There is nothing in the instant specification to show that appellant

³ This patent was cited in ¶ 3 of appellant’s declaration.

possessed any method broader than that of pages 9 and 10. The specie does not show possession of the claimed genera. [Answer, pages 6-7.]

The examiner states that appellant's "declaration provides conclusions without any scientific statement of fact about what the specification describes" and is of the opinion that "[a]lthough the patent cited by appellant . . . produces a magnetic brush which contacts the photosensitive member, the patent does not use the *same process characteristics* as in the" the specific embodiment of the specification "which is the *only possible source of support* for the manipulative steps claimed," and thus the "specification also fails to enable the formation of a magnetic brush" (answer, pages 10-12; emphasis supplied).

Appellant, in his reply brief, reviews several United States Patents and finds that none disclose "examples in any different manner from" the specific embodiment in the specification (pages 1-4). Appellant further cites United States Patent No. 4,911,100 for the description of "several different 'magnetic brush' patents" in support of the proposition that "it is well within the skill of the ordinary artisan to . . . form a magnetic brush" and thus the "specification, in combination with conventional knowledge, is therefore enabling of the claimed invention" (*id.*, pages 5-6).

Both the examiner and appellant base their case on their respective views of the description that one skilled in this art would find in the specific embodiment of the specification vis-à-vis the method of the appealed claims. While we agree with appellant that, based on the evidence in ¶ 3 of appellant's declaration and the cited patent literature, one skilled in this art would necessarily find a description equivalent to a "magnetic brush" in said embodiment, we cannot agree with appellant that the evidence submitted shows that this person would reasonably recognize in the same disclosure a description of the claimed methods as defined by the claims which establishes that appellant was in possession of said methods, including each of the limitations stated therein, as of the effective filing date of this application. Indeed, appellant has testified in ¶ 4 of his declaration that it would have been apparent, that is, *obvious*, to one skilled in the art from the specified embodiment that the method of claim 7 is merely *among* the contact-type developing methods utilizing a magnetic brush that appellant *envisioned*, which testimony, even if coupled with the alleged predictability with respect to the enablement that one skilled in the art would find in the specific embodiment, does not establish that this disclosure reasonably provides the requisite written description within the meaning of the statute. *See*

Lockwood, supra. With respect to the matter of predictability raised by appellant and to the enablement issue raised by the examiner, it is well settled that compliance with § 112, first paragraph, enablement requirement, is a separate issue from compliance with the written description requirement and thus that the scope of enablement provided by a disclosure does not necessarily equate to the description of an invention that one skilled in the art would reasonably recognize therein. *See generally, Vas-Cath*, 935 F.2d 1555, 1561-64, 19 USPQ2d at 1115-17, and cases cited therein. Accordingly, if one skilled in the art would find that the specific embodiment was the sole disclosure in appellant's specification pertaining to the claimed methods of claims 7 and 8, we would be in agreement with the examiner's position that one skilled in the art would not have reasonably recognized therein a description of the invention encompassed by the claims, including all of the limitations thereof as stated in the claims.

However, contrary to the position taken by the examiner and appellant, it is readily apparent from the specification that the specific embodiment is not the "only possible source of support" in the disclosure which would be considered by one skilled in this art with respect to the issue of compliance with the written description requirement of § 112, first paragraph. While the examiner in his answer has considered *only* that disclosure of the specification beginning at page 4 thereof (*see supra* p. 4), we find that the thrust of appellant's disclosure as set forth in the "Summary of the Invention" is "to solve the problems in the *above prior art* and provide a toner for developing an electrostatic latent image which is good in ease of clearing, namely, which can easily be removed from the surface of an image carrier after transfer" (specification, page 4, lines 8-12; emphasis added). We further find that the "above prior art" includes the "conventional" prior art methods involving the development of an "electro-static latent image" into "a toner image by brushing with a so-called magnetic brush composed of a developer" in conventional "developing means" and the "conventional" prior art processes for "producing a toner constituting the aforesaid developer" disclosed in the "Background of the Invention" (*id.*, page 1, line 2, to page 4, line 6). We find that within the portion of the specification discussed by the examiner in the answer, appellant discloses that the toner "for achieving the above objective" is prepared by adding to the surface of toners of specified composition and size a "finely powdered

cleaning assistant” in a specified amount, wherein the ingredients can include those necessary to “obtain a so-called magnetic toner” (*id.*, page 1, line 2, through page 4, line 21). Indeed, we find that within pages 1 through 5, line 10, of the specification are disclosed each and every limitation of claims 7 and 8.

Because we find that the examiner has not considered the entire disclosure in appellant’s specification which pertains to the claimed invention of claims 7 and 8, we must conclude that the examiner has not made out a *prima facie* case that the appealed claims do not comply with § 112, first paragraph, written description requirement. Accordingly, we reverse this ground of rejection.

The examiner’s decision is reversed.

Reversed

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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